

REMARKS

The pending Office Action addresses and rejects claims 1-18.

Amendments to the Claims

Applicant amends independent claims 1, 13, and 18 to include the limitations of claims 2-4, which are now cancelled. Claims 1, 13, and 18 are also amended to recite a horizontal line that extends from the left eye to the right eye, and a vertical line that extends from the upper edge to the cutout portion. Support for this amendment can be found throughout the specification and in the drawings, for example, in FIG. 1. No new matter is added.

Rejection Pursuant to 35 U.S.C. §103

The Examiner rejects claims 1, 5-8, 10-13, and 15-18 pursuant to 35 U.S.C. §103(a) as being obvious over Kokuni in view of U.S. Patent 3,718,145 of Chateau. The Examiner argues that Kokuni discloses the claimed invention, but fails to teach alignment markings for aligning the template. Thus, the Examiner relies on Chateau to disclose a “fleur-de-lis” design located between the eye holes for aligning the template. The Examiner also rejects claim 9 pursuant to 35 U.S.C. §103(a) as being obvious over Kokuni in view of U.S. Patent No. 5,186,190 of Hirzel.

Independent claims 1, 13, and 18 are amended to recite a “horizontal line” and a “vertical line.” Neither Kokuni or Hirzel teach or even suggest horizontal and vertical lines, as claimed. Claims 1, 13, and 18 therefore distinguish over the cited references.

Applicants further note that the Examiner’s assertion that “Applicant has not claimed the markings being in contact with the eyehole or the upper or lower edges” is incorrect. Independent claims 1, 13, and 18 clearly recite a horizontal marking that extends from the upper edge to the cutout portion, and a vertical marking that extends from the left eye to the right eye. In order to extend from one element to another, the line must be in contact with the element recited. The claims do not recite lines extending between two components. Claims 1, 13, and 18 therefore further distinguish over the cited references.

Applicants also note that no person having ordinary skill in the art would modify Kokuni to include a fleur-de-lis as taught by Hirzel and suggested by the Examiner. The purpose of the fleur-

de-lis in Hirzel is to align the eyebrow stencil on the user's face. This is necessary because the eyebrow stencil does not include eyeholes to facilitate alignment. Kokuni, on the other hand, does include eye holes for properly positioning the stencil on the user's face. Thus, there is no need to use any type of alignment feature, such as a fleur-de-lis or other markings, to properly position the stencil on the user's face.

The Examiner fails to apply the legal requirement that the prior art be shown to provide sufficient motivation to one of ordinary skill in the art to combine the references. In combining references in an obviousness rejection, an examiner may not simply pick and choose elements from different references, but must identify a teaching or motivation to combine the elements. The Federal Circuit has stated:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). *See also Graham*, 383 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. *See, e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.").

In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. April 28, 1999).

The Examiner has not provided clear and particular reasons for providing the template of Kokuni with the marking taught by Chateau, but simply concludes that the requisite motivation exists “for the purpose of centering the template to facilitate symmetrical application of the eyebrow makeup” Kokuni, however, already provides eyeholes for centering the template to facilitate symmetrical application of eyebrow makeup. This type of conclusory statement falls well short of the requirement to specifically identify the reasons why one of ordinary skill in the art would be motivated to combine the references.


Independent claims 1, 13, and 18 therefore distinguish over Kokuni and Chateau and represent allowable subject matter. Dependent claims 9, 11-12, and 14 are allowable at least because they depend from an allowable base claim.

Conclusion

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Dated: July 26, 2006

Respectfully submitted,

By 
Lisa Adams
Registration No.: 44,238

NUTTER MCCLENNEN & FISH LLP
World Trade Center West
155 Seaport Boulevard
Boston, Massachusetts 02210-2604
(617) 439-2550
(617) 310-9550 (Fax)
Attorney for Applicant